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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,959	02/17/2004	Ralph Lance Carter	03142-P0067A	9116
24126	7590	08/02/2005	EXAMINER	
ST. ONGE STEWARD JOHNSTON & REENS, LLC 986 BEDFORD STREET STAMFORD, CT 06905-5619			LYONS, MICHAEL A	
			ART UNIT	PAPER NUMBER
			2877	

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/779,959

Applicant(s)

CARTER ET AL.

Examiner

Michael A. Lyons

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,5 and 8-10 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,4,5 and 8-10 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 16 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the United Kingdom on August 17, 2001. It is noted, however, that applicant has not filed a certified copy of the foreign application as required by 35 U.S.C. 119(b).

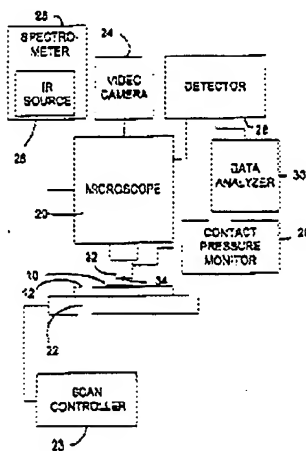
Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-5, and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dukor (5,945,674).



Regarding claims 1 and 5, Dukor (Fig. 2) discloses a system and corresponding method for operating a FT-IR microscope 20 with a scanning spectrometer 25 in continuous scan mode since nothing indicates that the spectrometer ever stops scanning that features an object stage 22 that is coupled to a scan controller 23 that moves the stage in conjunction with the scan of the

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spectrometer; Dukor discloses that "after the ATR infrared measurement is performed on one detection site in the sample, the object stage 22 is moved under the control of the scan controller so that the next detection site is positioned for ATR infrared measurement".

As for claims 4 and 8, Dukor discloses detector 28.

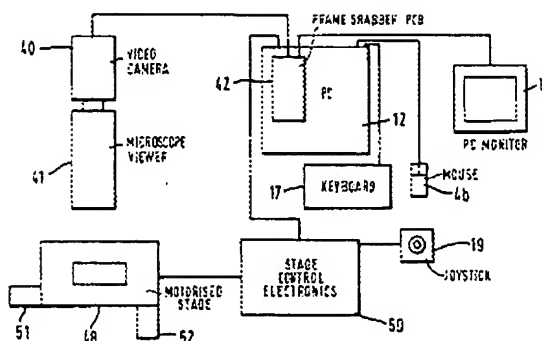
Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dukor (5,945,674) in view of Carter (6,006,140).



As for claims 9-10, Dukor discloses a data analyzer 30 for producing signals from the detector and a scan controller for controlling the microscope stage.

Dukor, however, fails to disclose an explicit scan controller for controlling the spectrometer, and a master controller for controlling the device as a whole.

Carter (Fig. 3) discloses the use of a PC 12 as a master controller for controlling the stage control 50 and video camera 40 of an infrared microscope stage control device. And, although no controller is disclosed for control of the spectrometer itself, Official Notice is taken as to the well known use of a controller for a spectrometer, since a controller would be inherent to the spectrometer to facilitate proper function. This master controller would inherently facilitate the passage of signals from one controller of the device to another.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add an explicit controller to the spectrometer, and an additional computer as a master controller for the device as a whole in order to facilitate more precise, centralized control of the operation of the entire combined apparatus and method.

Response to Arguments

Applicants' arguments filed May 16, 2005 have been fully considered but they are not persuasive.

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The applicants arguments focus on the claim that the moveable stage of the telescope is incrementally moved in response to a signal generated at the completion of a spectrometer scans, and the assertion that the prior art fails to disclose this function. The applicants claim that, “by using this feature the synchronization is effectively driven by the spectrometer”. While the examiner does not necessarily disagree with this statement, the claim language fails to explicitly disclose this feature. The amended claim states, “Movement of the microscope stage is initiated in response to a signal generated at the completion of a spectrometer scan”. This language does not explicitly disclose that the spectrometer itself is controlling the movement of the stage; rather, just a signal generated at the end of the scan is controlling the stage movement. Such a signal may be generated by the central controller (a computer or similar device) that then initiates the movement of the stage at the end of the scan, since it is not clear what exact element is generating the signal. Accordingly, this interpretation leads the examiner to the conclusion that the prior art continues to read on the claims, in their current form, allowing the rejection to stand.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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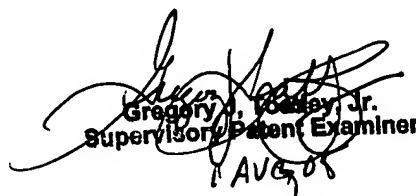
CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Lyons whose telephone number is 571-272-2420. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley can be reached on 571-272-2800 ext. 77. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MAL
July 28, 2005


Gregory J. Toatley, Jr.
Supervisory Patent Examiner
AUG 5 2005